

***United States Court of Appeals
for the Second Circuit***



APPELLEE'S BRIEF

74-1774

United States Court of Appeals

FOR THE SECOND CIRCUIT

73 Civ. 4865

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P/S

HERBERT ROSENTHAL JEWELRY CORPORATION,

Plaintiff-Appellant,

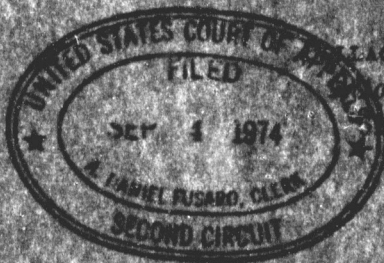
—against—

**HONORA JEWELRY CO., INC., JERRY J. GROSSBARDT
and STANLEY SCHROETER,**

Defendants-Appellees.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

APPELLEES' BRIEF



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Preliminary

The District Court (Brieant, *J.*) correctly dismissed the Complaint in this copyright infringement action since defendants' jeweled turtle pin is so obviously and admittedly dissimilar from plaintiff's allegedly copyrighted turtle pin that no claim of copyright infringement is possible (64a-74a).*

The District Court had both pins before it and was able by "visual examination" (68a) to see numerous significant differences between the two pins.** In addition,

* References are to pages in Joint Appendix or Exhibit Book.

** This is a non-jury case.

the District Court had before it the sworn deposition of plaintiff's President, in which he had admitted under oath (without dispute in the moving papers) that there were at least a dozen obvious and significant differences between plaintiff's pin and defendant's pin (49a-51a). Thus, the District Court concluded (70a):

"The differences observed in the turtles by the Court, taken together with the differences conceded by Mr. Herbert Rosenthal on his deposition, compel a finding of no infringement, and also compel the inference of originality, rather than copying."

This conclusion by the District Court had been invited by plaintiff itself which, in its supporting memorandum on the motion below, had specifically argued to the Court that:

"This issue of infringement can be determined by this Court, without the need for a trial, by a mere visible [sic] comparison of the two pins . . ." (68a).

Accepting this invitation and concession, the District Court (a) denied plaintiff's motion for summary judgment and (b) granted summary judgment to defendant dismissing the Complaint. This result was correct and should be affirmed.

The Facts and Prior Proceedings

Plaintiff brought this action for copyright infringement, claiming that defendants were "simulating in design" a jeweled turtle pin (Exh. A; E.B. 4) as to which plaintiff claims to have a copyright (5a at ¶12).*

* A prior dispute between the plaintiff and the individual defendants, involving a different turtle pin of defendants, was

Defendants denied copying plaintiff's pin (7a) and supplied evidence below that, in designing and making their pin (Exh. B; E.B. 5), they had not copied plaintiff's pin, but rather had developed it independently on their own (25a, 34a, E.B. 6-7). Plaintiff's President admitted on his deposition that he had no evidence that defendants had copied their pin from his, but rather was relying in this action solely upon what he conceived to be the similarity between the two pins.

The two pins are markedly dissimilar (51a-52a, 66a). As admitted under oath by plaintiff's President on his deposition, there are at least a dozen significant differences between the two pins.* Those differences are obvious from a visual examination of the two pins; indeed, in its motion papers below, plaintiff itself asked the District Court to decide the infringement issue summarily on the basis of a mere visual examination of the two pins (68a). The differences include the following:

- a. the gold in the defendants' pin is much lighter in weight than that of the plaintiff's pin;
- b. the defendants' pin is two solid pieces, but the plaintiff's pin is three pieces soldered together;
- c. the back of the defendants' pin is open, but the back of the plaintiff's pin is covered;

resolved by consent decree in 1971 (17a). Although plaintiff attempts, in its brief, to inject that prior dispute by innuendo into this action, it has no bearing at bar, since the defendants' pin there was admittedly a different pin and dissimilar from that here at issue.

* Plaintiff's brief to this Court acknowledges both that there are several obvious differences and that they are apparent upon mere visual examination (Br., p. 7):

"When the pins are placed side by side, certain differences appear in the position of the head, tail and shape of feet. Then too in order to produce a cheaper product, defendants made their turtle flatter."

d. the defendants' pin is half the thickness of the plaintiff's pin;

e. the head of the plaintiff's turtle juts straight out from its body, while the head of the defendants' turtle is placed at an angle;

f. the head of the plaintiff's pin has a matted finish, whereas the head of the defendants' pin has a lined finish;

g. the head of the plaintiff's pin is closely attached to the body by comparison with the defendants' pin, which extends further out;

h. the head of the plaintiff's pin shows a clearly demarcated mouth and two stones for eyes, but the head of the defendants' pin shows no mouth and the eyes are plain gold beads;

i. when viewed from the side, the heads are raised at distinctively different angles, the plaintiff's pin far less than the defendants' pin;

j. the plaintiff's pin has a short stubby tail, while the defendants' pin has a longer curved tail;

k. the body of the plaintiff's pin is divided into some 27 rounded sections, with a fringe of nugget gold, while the body of the defendants' pin is divided by straight lines into 10 sections and there is no such fringe;

l. the feet of the plaintiff's pin are flat and rounded off, where the feet of the defendants' pin show three clearly defined toes (25a, 49a-51a).

Thus, plaintiff's President made the following sworn admissions—none of which were disputed in the moving papers—on his deposition (49a-51a):

By Mr. Pollack:

"Q. Mr. Rosenthal, I show you your pin A and their pin B, and ask you whether you note any differences between them and, if so, whether you can tell us the differences? A. The differences, they are much lighter.

Q. Theirs is much lighter? A. Yes.

Q. Are there any other differences? A. Just the outside perimeter is different.

Q. In what respect? What is the outside perimeter difference? A. Mine is nugget gold and theirs is some attempt at it.

Q. Are there other differences? A. That is the only one I could see.

Q. Do you note for example that the tail on your pin is straight and that the tail on their pin is somewhat curved? A. Agreed.

Q. Do you note that your pin has jewelry stones in the eyes and their pin does not? A. Agreed.

Q. Do you note that your pin has flat feet and that their pin has feet that indicate toe differentiations? A. Right.

Q. Do you note that when you turn the pins backside up, that your pin has a gold base holding it together and their pin has no base holding it together? A. Right.

Q. Do you note that the head on your pin has a matted finish and that the head on their pin has a lined finish? A. Actually there is no difference between the matting. As far as the lined finish you need a loupe for that to find out what you mean by a lined finish.

Mr. Pollack: We will go back to that question when we get the loupe.

Q. Do you note that the head on your pin comes straight out from the body, whereas the head on their pin is at angle from the body? A. Agreed.

Q. Is it correct that the body of your pin has 27 rounded sections?

Mr. Sonnenreich: What do you refer to as a section?

Mr. Pollack: I would assume it would refer to these. (Indicating).

Mr. Sonnenreich: How would you describe it?

The Witness: Little nubs.

Q. Little nubs. Yes. Do you note there are 27 on your pin? A. Correct.

Q. Correct? A. Right.

Q. Do you note that the body of their pin has only ten rounded sections with straight lines, or ten nuggets, as you have described them, with straight lines?

Mr. Sonnenreich: That's not nuggets.

A. This is not nuggets. This is already lined sections.

Q. In other words, the sections on their pin are different from the sections on yours? Yes? A. Right.

Q. And there are only ten on theirs? A. Right.

Q. Do you notice that the model of your pin is two pieces with the top soldered on to the bottom frame? A. Yes.

Q. And that the model of their piece is all a single piece? A. That I would have to ask a jeweler, because it looks to me like two pieces on there. I would have to have an authority on it.

Q. Is it correct that your pin has an overall thickness of approximately eight millimeters? A. I would have to have a gauge to give you a direct answer.

Q. Well, without the gauge can you testify that the defendants' pin is half the thickness of the Rosenthal pin? A. Yes.

Q. We think one is eight millimeters and the other is four millimeters? A. Right.

Q. Do you note that your pin has a line for the mouth and their pin does not even have a mouth? A. Can I have the loupe, please? Yes."

The differences were so substantial that the District Court in a learned discourse on the subject was able to discern in the pins two different species of turtle: defendants' a fresh water turtle; plaintiff's a land turtle with marine feet (70a).

As a matter of law, these admitted and obvious differences render impossible any claim of infringement at bar, as the District Court correctly held.*

* Plaintiff raises no objection in its brief on appeal, as it can not, to the District Court's granting of summary judgment to defendants even though they had not expressly moved for such relief. The law is clear that, upon finding that there are no issues of fact to be tried, it is entirely proper for the District Court to do so. See, e.g., *First Nat. Bank in Yonkers v. Maryland Casualty Co.*, 290 F.2d 246, 251 (2d Cir. 1961), cert. denied 368 U.S. 939 (1961); *Abrams v. Occidental Petroleum Corp.*, 450 F.2d 157 (2d Cir. 1971).

POINT I

The District Court correctly held that there could be no possible claim of infringement since the two pins were obviously and admittedly dissimilar.

Plaintiff claims that it has the right to protect by copyright the "essence" of its design, which it describes as the idea of a gold turtle pin with 10 gemstones on its back, and to prevent the sale of any other gold turtle pin which has the same number of jewels on its back (56a-57a).^{*} This is simply wrong.

First, as the District Court properly observed, and as plaintiff's President acknowledged under oath, the two pins are markedly dissimilar, so that it is obvious that defendants' pin is not a copy of plaintiff's pin. It is well-settled law that where there is no copying, there can be no infringement. *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954); *Herbert*

^{*} On his deposition, plaintiff's President summarized plaintiff's claim as follows:

By Mr. Pollack:

"Q. Well, surely you do not claim that a turtle is something that is copyrighted to you, that the idea of a turtle, jeweled turtle pin is copyrighted by you, do you? A. Well, that particular one with the ten stones on top is definitely my type of design.

Q. Well, is that what makes it special to you, the ten stones on top? A. To me, to my thinking, it is special to me.

Q. The ten stones? A. Yes.

Q. Is there anything else that makes it special to you? A. And the whole concept of the turtle with ten stones.

Q. In other words, someone could make a turtle without the ten stones and he wouldn't be infringing your copyright, is that correct? A. Right.

Q. Is there any other element of it besides the ten stones which you claim is unique to you? A. Well, that is what I am basing my complaint on.

Q. The ten stones? A. Ten stones and general idea to simulate my type of turtle." (56a-57a, 71a-72a).

Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 741-42 (9th Cir. 1971).

Moreover, there can be no claim of infringement at bar, as a matter of law, since the law protects not what plaintiff claims is his copyright (i.e., the "idea" of a turtle pin and the mere "concept" of 10 jewels on its back), but rather only plaintiff's particular "expression" of that idea or concept (i.e., the design of plaintiff's particular pin). *Mazer v. Stein*, *supra*, 347 U.S. at 217-18; *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, *supra*, 446 F.2d at 741-42.

As Mr. Justice Reed stated for the United States Supreme Court in *Mazer v. Stein*, *supra* (347 U.S. at 217-18):

"Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself. Thus, in *Baker v. Selden*, 101 US 99, 25 L ed 841, the Court held that a copyrighted book on a peculiar system of bookkeeping was not infringed by a similar book using a similar plan which achieved similar results where the alleged infringer made a different arrangement of the columns and used different headings . . . The copyright protects originality rather than novelty or invention—conferring only 'the sole right of multiplying copies.' Absent copying there can be no infringement of copyright. Thus, respondents may not exclude others from using statuettes of human figures in table lamps; they may only prevent use of copies of their statuettes as such . . ."

At bar, the District Court correctly observed that the use of 10 stones on a turtle's back is a mere representation of the natural division of any turtle's carapace into

10 or 12 segments (62a, 72a).^{*} Plaintiff's brief incorrectly calls the District Court's conclusion "internally inconsistent" and seeks to raise the false issue of originality. While originality of a design is frequently at issue in copyright infringement cases, it is not at issue here. The issue at bar is copying since, as noted above, if there is no copying, there can be no infringement.

Rosenthal has neither adduced nor alleged any evidence of copying at bar, claiming only that the two turtle pins were made of gold and had ten stones (12a, 30a, 71a-72a). This is simply inadequate. The fact that turtles exist in nature, each with 10 to 12 segments on their shells, demonstrates that the 10 stones, like the existence of a shell itself, or the general turtle shape, are not copyrightable matter and cannot be taken by themselves as any kind of proof of copying.

Plaintiff also incorrectly relies on certain decisions in this Circuit involving alleged infringement of copyright in fabric designs. In those cases either copying was not at issue, or there was no relevant evidence to contradict the claim of copying for the Court's review except the fabric samples themselves. At bar, not only is copying denied, but defendants have demonstrated by contemporaneous documentary evidence the independent source for their pin (7a, 25a, 34a, 66a-67a, E.B. 6-7).^{**}

^{*} This conclusion is further consistent with the practice of the U.S. Copyright Office, as explained to one of the defendants, not to grant a copyright for a mere arrangement of stones (35a-36a).

^{**} As a minimum, this proof of the independent origin of defendants' pin which they brought forth would have barred summary judgment for plaintiff on the issue of infringement. *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661 (2d Cir. 1939); *Monogram Models, Inc. v. Industro Motive Corp.*, 448 F.2d 284 (6th Cir. 1971).

Finally, the fact that both pins were or might be set with diamonds, rubies, sapphires or other stones, alone or in combination, surely can add nothing to plaintiff's claim of substantial similarity. With what else would one expect a piece of jewelry to be set? These are the common subject matter of the jeweler's art. If plaintiff were correct, then one poem could be said to infringe another because it is set in type and printed on paper.

CONCLUSION

For the reasons stated, the judgment below should be affirmed, with costs.

Respectfully submitted,

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